REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on November 15, 2006, the Examiner required a new oath or declaration, objected to claim 16 as being dependent on a canceled claim, and rejected claims 1-14, 16-19 and 21-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,571,245 to Huang et al. (hereinafter "Huang"), in view of U.S. Patent Number 6,339,787 to Yohe et al. (hereinafter "Yohe"), and further in view of U.S. Patent No. 6,728,760 to Fairchild et al. (hereinafter "Fairchild"). The Examiner also rejected claims 20 and 26 under 35 U.S.C. §103(a) as being unpatentable over Huang, Yohe, and Fairchild and further in view of U.S. Patent Number 6,122,351 to Schlueter, Jr. et al. (hereinafter "Schlueter"). Accordingly, Applicants respectfully provide the following.

Claim Objections:

Applicants have amended claim 16 so it now depends from claim 14. Applicants therefore respectfully request withdrawal of the objection to claim 16.

Oath/Declaration:

Pursuant to 37 CFR 1.111 (b) Applicants request that the Examiner's request for a new oath/declaration, a formal matter, be held in abeyance until allowable subject matter is indicated. See MPEP 714.02 (8th Ed., Rev. 3, August 2005) ("presentation of a new oath and the like are generally considered as formal matters").

Claim Rejections under 35 U.S.C. §103(a):

As mentioned above, the Examiner rejected all claims under 35 U.S.C. §103(a) as being unpatentable over various combinations of references including Huang and Yohe in view of Fairchild. In light of this rejection, Applicants provide the following remarks. The standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicants respectfully submit that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicants also respectfully submit that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

Failure of the art to teach all claim limitations:

Specifically, all independent claims include language that clearly distinguishes over the cited art. Claim 1 includes language requiring "information access control controlling the sharing of information requested by the at least one client by maintaining a list of those clients requesting the information and forwarding updates of the information as the updates occur to those clients on the list only, wherein the information access control includes a smart cache

controller to manage information accessed by one or more clients, and wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information." Applicants respectfully submit that this limitation is not taught by the cited references, alone or in combination.

In the Office Action, the Examiner suggested that Huang teaches maintaining a list of those clients requesting the information and forwarding updates of the information to those clients on the list only, citing column 18, lines 27-46. Applicants respectfully disagree. This section of Huang only teaches providing a list of users allowed to access and update a user's calendar; this portion of Huang does not teach forwarding updates of the information to those users on the list who are granted access. (Col 18 lines 36-38) Particularly telling is a direct quote of the language relied on by the Examiner, which shows how little support is provided by the cited language:

> The calendar database includes information on the user's calendar, and is partitioned into two smaller databases for the calendar event and the calendar sharing. Calendar sharing database includes the list of users authorized to access and/or update another user's calendar.

(Col 18 lines 33-38) Applicants respectfully submit that this language does not teach "forwarding updates of the information to those clients on the list only," as the Examiner suggested. Rather, this section is completely silent as to forwarding updates of information to clients on the only list disclosed, the list of users authorized to access/update the calendar. Quite simply, allowing access to is not the same as forwarding updates of.

In the current Office Action, the Examiner has at least acknowledged that Huang fails to teach forwarding updates of the information as the updates occur. The Examiner instead relies

on the newly-cited reference, Fairchild, as teaching forwarding an update, as it occurs, citing column 2, line 27-column 3, line 28. Applicants respectfully disagree with the Examiner's reading of Fairchild. Fairchild does not teach the forwarding of an update of the discussed media files, let alone the claimed "forwarding updates of the information as the updates occur to those clients on the list only." Claim 1 requires the forwarding of updates of the actual information as the updates occur, not of a mere notification that the information has been changed as the update occurs, with a later request for the updated information from those receiving the notification. This is what is actually taught by Fairchild.

Fairchild teaches a system for delivery of computer media over a network of computers wherein when a media file is updated, a bare notification of the update may be sent out to those computers maintaining a shortcut link to the information or having a copy of the media file. (Abstract lines 15-19, Col 2 lines 48-58, Col 5 lines 3-8, Col 6 lines 59-65, for example.) However, the updated media files are not actually sent out with the notification, but are later downloaded separately by those desiring the updated media files. (Col 3 lines 48-54, Col 7 lines 41-51, for example.) Therefore, though Fairchild teaches sending out a notification of updates when the updates occur, Fairchild does not teach the claimed limitation of "forwarding updates of the information (analogous to the media files of Fairchild) as the updates occur."

In the most recent Office Action, the Examiner indicated that Huang and Fairchild fail to teach information access control including a smart cache controller. Applicants agree. The Examiner then indicated that Yohe teaches a smart cache controller. However, Applicants respectfully contend that Yohe does not teach "wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of

the information as the updates occur to those clients on the list only based on registered interests of the clients in the information," as is required by claim 1. Yohe does not teach that updates are shared only with clients requesting information and contained on any list, does not teach forwarding information based on registered interests of the clients in the information, and does not teach forwarding updates of the information as the updates occur. (None of these specific limitations is taught by the cited portions of Columns 3, 4, or 9 of Yohe, relied upon by the Examiner.) Rather, the Examiner has instead indicated that it would have been obvious to one of skill in the art to not only add Yohe to the other cited references, but to also go beyond what was taught by Yohe to provide what is required by claim 1. Applicants respectfully submit that the Examiner has improperly rejected claim limitations without foundational basis, as Yohe does not teach these claim limitations. Thus, none of the cited references, alone or in combination, teach these limitations.

Yohe specifically teaches that updates to information contained in cached stores are updated in response to specific action requests by a requesting computer, not "as the updates occur." (Col 9 lines 29-45 (Open request), Col 9 lines 46-60 (Read request), Col 10 lines 21-32 (Write request), etc.) Thus, Yohe teaches away from the claimed system wherein updates are shared and forward "as the updates occur," and teaches instead that updates are passed along only as requested. No listing of clients requesting the information and with registered interest in the information is disclosed at all.

Therefore, Applicants respectfully submit that none of the cited references, alone or in combination, teach the above-discussed limitations. Neither Huang, nor Fairchild, nor Yohe, nor any combination thereof, teaches the above-discussed claimed limitations of "maintaining a list

of those clients requesting the information and forwarding updates of the information as the updates occur to those clients on the list only" and a smart cache controller "wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information." Because the cited references, alone or in combination, fail to teach the claimed language, Applicants respectfully submit that claim 1 is not made obvious by the cited combination of references.

Lack of motivation to combine references in the manner suggested by the Examiner:

Applicants further submit that one of skill in the art would not be motivated to combine references in the manner suggested by the Examiner. There must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify or combine what the reference teaches. Huang and Yohe fail to suggest the combination of the prior art references suggested by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." In re John R. Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990). A "clear and particular" showing

of the suggestion to combine is required to support an obviousness rejection under Section 103. MPEP § 2142.

In the Office Action, the Examiner alleged that one of skill in the art would be motivated to combine Huang and Fairchild to keep the "subscribed" users instantly informed of changes. As has happened repeatedly in the past, the Examiner provided no citation to either cited reference as teaching this motivation. Applicants respectfully submit that the Examiner has therefore failed to comply with the requirements that any such alleged suggestion must be "found in the prior art" and that the showing of the suggestion must be "clear and particular." Applicants have reviewed Huang and Fairchild and have found no reference to "subscribed" users being instantly informed of changes. Additionally, even accepting that Fairchild provides some information of changes to interested users, nothing in Huang suggests that providing such information is useful in the Huang calendar system. The purpose of Huang is to allow others to access and update a single user's calendar. The very updating of Huang's calendar already provides that information to the user whose calendar is updated. Nothing in Huang suggests that any other users, let alone "subscribed" users need or want to be informed of changes to the user's calendar. Therefore, there is clearly no motivation to combine Fairchild and Huang in the manner suggested by the Examiner.

Furthermore, in the Office Action, the Examiner alleged that one of skill in the art would be motivated to modify Huang and Fairchild in view of Yohe (beyond what Yohe even teaches, as set forth above). The Examiner indicated that one of skill in the art would be motivated to do so "because it helps increase data access in a network," citing Yohe column 3 line 37. Applicants respectfully disagree. While Yohe teaches a caching system that increases the speed

of data access in a network, the method it uses is complicated and requires a fair amount of processing power. Specifically, the Yohe method requires generating a data signature for each block of data to be accessed at a client computer and at a file server/cache verifying computer. (Col 3 lines 43-56) This extra processing use is justifiable in the case of slower network access conditions, such as in a slow modem connection, as the extra time used is offset by the saved time in not re-downloading identical information over the slow connection. (Col 2 line 64-Col 3 line 11) However, this system does not provide the benefit cited by the Examiner of helping "increase data access in a network" for the system claimed in claim 1.

Specifically, as discussed above, the system of Yohe does not provide updates as they occur to other clients, but only provides a comparison upon request between the information on one client and on the file server. (See Yohe Figure 2, and the discussion above.) Thus, adding Yohe to Huang does not solve the problems solved by Applicants' claimed invention. Furthermore, the system of Huang uses its own system for updating and synchronizing file information between file servers and the computer using the web-based virtual desktop that uses minimal network resources, far less processing power than used by the system of Yohe, and achieves all the needs of Huang. Specifically, Huang uses synchronization based on the last edit date of the to-be-synchronized file on each system. (Col 12 lines 20-29) Thus, one examining the systems of Huang and Yohe would not be motivated to combine the references, as no discernable advantage would be provided from the combination, especially as it relates to updating the calendaring database of Huang relied upon by the Examiner.

In the Office Action, the Examiner refused Applicants' arguments regarding the failure of Yohe to teach any motivation to combine the references in the manner suggested by the

Examiner. However, the Examiner failed to directly address any of Applicants' contentions above, but instead merely cited again to a single phrase of Yohe that reads "an apparatus for increased data access in a network." If the Examiner continues to maintain that Yohe provides motivation to combine the references in the manner suggested by the Examiner, Applicants respectfully request that the Examiner address, in detailed fashion, Applicants' above arguments.

Applicants respectfully submit that under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Huang, Fairchild, and Yohe in the manner suggested by the Examiner. Only by inappropriately using the roadmap of the present invention would an artisan of ordinary skill combine these two references in such a manner. In essence, Applicants urge that the combination of the listed references is not a product of a suggestion contained within them, but a product of inappropriate hindsight analysis. "Hindsight reconstruction" cannot be used "to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Ecolochem, Inc. v. S. California Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000) (quoting In re Fine, 837 F.2d 1071 (Fed. Cir. 1988)). Rather, "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." Id. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight." Id. (quoting In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999)).

In light of the absence of any suggestion or motivation to combine the above-referenced prior art, the mere fact that such prior art could be combined in a matter suggested by the

Examiner does not render the present inventor obvious, especially given the fact that the suggested combination fails to arrive at the claimed invention. Under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Huang, Fairchild, and Yohe in the claimed manner.

Therefore, because the cited references fail to teach every claim limitation of claim 1, because there is no motivation to combine references in the manner suggested by the Examiner, and because one of skill in the art would not expect success in doing so, Applicants respectfully submit that claim 1 is not made obvious by the cited references.

Other claims:

Independent claims 8, 14, and 21 contain similar limitations to those discussed in relation to claim 1, and are at least allowable for the same reasons. All other remaining claims depend from one of these independent claims, and are also therefore allowable. Applicants therefore respectfully request removal of all the rejections under 35 U.S.C. § 103(a).

CONCLUSION

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 14 day of March, 2007.

Respectfully submitted,

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